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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,197	09/12/2003	Arthur D. Taylor	11653-004001	9365
26161	7590	08/15/2006	EXAMINER	
FISH & RICHARDSON PC			ALEXANDER, MICHAEL P	
P.O. BOX 1022			ART UNIT	
MINNEAPOLIS, MN 55440-1022			PAPER NUMBER	

1742

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/662,197	Applicant(s) TAYLOR, ARTHUR D.	
	Examiner Michael P. Alexander	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 7-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim(s) 1-19 is/are pending. Claims 7-19 are withdrawn from consideration.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poliero et al. (US 2003/0012679 A1).

Regarding claims 1-4 and 6, Poliero et al. teach (see abstract) a gold alloy comprising by weight at least 33% gold and at least 66% copper and that the gold alloy can also comprise less than 20% nickel, less than 25% zinc, and less than 4% cobalt. This teaching overlaps with the claimed composition of 91.67 % Au, 0.66% Zn, 7.00% Ni, 0.60% Cu and 0.07% Co. It has been held that when ranges of the prior art overlap with the claimed range, it is prima facie evidence of obviousness. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art to select the desired

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amount of Au, Zn, Ni, Cu and Co from the ranges of Au, Zn, Ni, Cu and Co disclosed by Poliero et al. because Poliero et al. teach the same utility throughout the disclosed range. Furthermore, the Examiner asserts that the alloy of Poliero would inherently be suitable for work hardening or annealing because Poliero teaches substantially the same composition as that of the claimed invention. See MPEP 2112.01 I.

Regarding claim 5, Poliero et al. teach (paragraph 0030-0035) that the alloy would further include iridium, germanium and phosphorus. It is the applicant's burden to establish that one of these elements is excluded from his claims by "consisting essentially of" language. See MPEP 2111.03.

Response to Arguments

Applicant's arguments filed 15 May 2006 have been fully considered but they are not persuasive.

Firstly, the applicant argues that Poliero provides no teaching to use cobalt at all. The Examiner disagrees. See abstract which teaches that the gold alloy can comprise up to 4% of at least one of the elements from the group consisting of cobalt, manganese, tin and indium.

Secondly, the applicant argues that none of the embodiments of Poliero have gold content above 75%. In response, the Examiner notes that the rejection is over the Poliero's broad disclosure and not the preferred embodiments. See MPEP 2123.

Thirdly, the applicant argues that the rejection fails to provide the analysis required by MPEP 2144.05 II. In response, the Examiner asserts that the analysis of MPEP 2144.05 II is not required for a case of obviousness based on overlapping ranges

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in MPEP 2144.05 I. Also, see *In re Peterson* cited therein, in which a prima facie case of obviousness was upheld without a showing that each of the elements were result effective variables.

Fourthly, the applicant argues that overlapping ranges do not create a presumption of obviousness. In response, the Examiner asserts that he is obligated to follow MPEP 2144.05 I and in particular *In re Wertheim*, cited therein, which states that overlapping ranges do create a presumption of obviousness. Furthermore, the Examiner agrees that *In re Peterson* states that a somewhat narrower range would be sufficient to establish a prima facie case of obviousness, but *In re Peterson* does not state that a broader-than-somewhat-narrower range would not be sufficient. Additionally, applicant cites *In re Peterson* for the idea that when a reference's disclosed range is so broad as to encompass a very large number of possible distinct composition, it might not be prima facie obviousness. In response, the Examiner notes the word "might". This statement in *In re Peterson* is dictum and not precedential. Also, see *In re Baird* cited by the court in *In re Peterson*. In that case, the genus was composed of 100 million possible species and the court held that each species would not be prima facie obviousness.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Poliero (EP 1,266,974) is substantially duplicative of Poliero (US 2003/0012679).

Conclusion

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Alexander whose telephone number is 571-272-8558. The examiner can normally be reached on M-F 10:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V. King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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